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10/2/07

In re Application of:
Demasi, Douglas, D.
Serial No.: 09/845,999
Filed: Sept. 24, 2001
Docket: None
Title: UNIVERSAL FLYING HAWK

DECISION ON PETITION

This is a decision on the petition filed on Apr. 3, 2007 seeking to withdraw the finality of the Office action. This petition is being considered pursuant to 37 C.F.R. §1.181. There is no fee for this petition.

The petition is **DISMISSED**.

In the petition, the petitioner requests the following relief:

- (A) to set aside the final rejection from January 9, 2007;
- (B) to reverse the Examiner's refusal to enter Amendment After Final filed on February 20, 2007;
- (C) to reverse the Examiner's 35 U.S.C. §112, first paragraph rejection of claims 21-33, 38-42 and 44-51 for failure "to comply with the written description requirement"; and
- (D) to reverse the Examiner's rejection under 35 U.S.C. §112, first paragraph, that claims 21-33, 38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

On Feb. 20, 2007, the applicant proposed an amendment to the specification after final rejection was issued in order to distinguish the applicant's invention from prior art and thereby overcome the examiner's rejection. The examiner deemed the proposed amendment after final as containing matter not supported by the original application, and as such, the proposed amendment to the specification was not entered. Petitioner believes there is no issue of new matter involved in the rejected claims under the final rejection, and that no new search is required under M.P.E.P. § 707.07(g). Petitioner also contends that no new matter was raised and no need for further search that the rejected claims under the final rejection should be withdrawn and found allowable.

The record shows that:

- 1) On Oct. 18, 2006 the applicant responded to the examiner's first office action with an amendment.
- 2) On Jan. 9, 2007, the examiner issued a final rejection necessitated by the applicant's amendment.
- 3) On Feb. 20, 2007 the applicant filed an amendment after final stating the final was premature due to no clear issues have been reached and the new grounds of rejection were not necessitated by the amendment filed 10/18/06.
- 4) On Mar. 12, 2007, the examiner issued an advisory action stating that the proposed after final amendment to the specification of Feb. 20, 2007 was not entered because they raised new issues for consideration and search as well as raising new matter.
- 5) On Apr 3, 2007, the petitioner filed both the present petition and a notice of appeal.
- 6) On May 27, 2007, the petitioner filed an appeal brief in triplicate.

Discussion and Analysis

With regard to the requested Relief A, a determination as to if amendment filed on Oct. 18, 2006 necessitated the new grounds of rejection in the final Office action of Jan. 9, 2007 must be made by making a comparison of the amended claims 21, 28, 34-39, 44 and 45 filed on Oct. 18, 2006 and the previous corresponding claims of Jul. 5, 2006. In the non-final Office action of Sep. 26, 2006, the examiner applied prior art U.S. patents to Goudy (US Patent 3,650,234), Skaszynski (US Patent 1,099,575) and Schlueter (US Patent 3,320,625) in the rejection of claims 21-32, 34-36, 38-42 and 44-51. However, the applicant's amendment to the claims 21, 28, 34-39 and 44-45 filed on Oct. 18, 2006 added limitations regarding "flying through the air aerodynamically and separable into two sections, comprising a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air" which necessitated the new grounds of rejection in applying new prior art references to Zistl (DE4332216A), Clayton (US Patent 4,898,345) and Rock (US Patent 5,152,705) in the final rejection of claims 21-32, 34-36, 38-42 and 44-51. These newly added limitations were not claimed previously. This is a clear indication that the applicant's amendment of Oct. 18, 2006 responding to the first office action of Sep. 26, 2006 necessitated the new grounds of rejection in the final Office action mailed Jan. 9, 2007. The petitioner also contends that the final office action was premature because a clear issue had not been reached. This however, is incorrect because the final rejection was properly issued in accordance with MPEP § 706.07(a)¹.

With regard to the requested Relief B, the petitioner asserts that since the final was improper, the petitioner has a right to have the amendments after final entered. However, the record clearly indicates the final rejection was proper. Entry of amendments after final rejection is not a matter of right (see 37 CFR § 1.116). The review of the record shows that the examiner was in

¹ The M.P.E.P. § 706.07(a) states that: "the second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)."

compliance with proper examining practice as set forth in MPEP 714.13 in refusing entry of the after final amendment submitted Feb. 20, 2007. The examiner indicated in the advisory action of Mar. 12, 2007, the amendment to the specification contains issues of new matter which is an appealable issue. The examiner did not abuse his discretion or act in an arbitrary or capricious manner in denying entry of the proposed claims after final for the reasons stated. Therefore there is no basis for granting the relief requested.

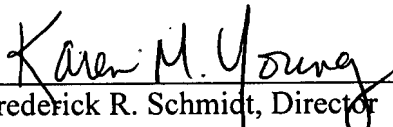
With regard to the requested Relief C and D, petitioner requests that the rejection of claims under 35 USC § 112 be reversed. Petitioner argues that the meaning of the phrase "deriving its lift in flight from forces resulting from its motion through air" is inherent in the phrase "kept airborne" and therefore, it does not constitute new matter. The meaning is also consistent with the rest of the specification and with the drawings and definitions in dictionaries. However, by applying the plain language of 37 CFR 1.181(a)(1)², it is clear that the petitioner's arguments will not support the requested relief, because the relief requested is simply not the type of relief that can be obtained by petition. The issues presented by the petitioner are clearly directed to the propriety of the examiner's rejection of the claims under 35 U.S.C. 112 1st paragraph. The question of whether or not the claims should be rejected under 35 U.S.C. § 112 is an issue suited for appeal. As such, it will not be decided by petition.

Conclusion

Based on the forgoing reasons the requested relief cannot be granted. The application is forwarded to the examiner in Art Unit 3714 for further preparation of examiner's answer.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED


for Frederick R. Schmidt, Director
Technology Center 3700

² 37 C.F.R. § 1.181(a)(1) states: "Petition may be taken to the Director: From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination preceding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court." [emphasis added]